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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,376	07/01/2003	Kazuhiko Isogawa	0033-0887P	1200

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EXAMINER

NUTTER, NATHAN M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,376

Applicant(s)

ISOGAWA, KAZUHIKO

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 703/703.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claims 3 and 4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3, drawn to a product-by-process of making a rubber thread depends, improperly, from composition claim 1. Likewise, claim 4, drawn to a golf ball depends, improperly, from a product-by-process claim for producing a rubber thread.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a "synthetic isoprene rubber having only a single peak," without being specific as to what measurements render a "single peak."

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1711

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamada et al ('939), newly cited.

The reference to Hamada et al ('939) teaches the manufacture of a golf ball that comprises a "thread wound core," wherein the threads are produced from a blend of "a natural rubber and a synthetic isoprene rubber having a cis-1,4 bond content of at least 90%," as herein recited and claimed. Note column 1 (lines 13-23) for the golf ball construction. Note the paragraph bridging column 2 to column 3 for the inclusions of the rubber constituents. Further, note column 4 (lines 19-26) for the vulcanization with sheet formation and thread production, and column 4 (lines 27-49) for the subsequent production of the golf ball using the rubber threads. Note Tables 1 and 2 at column 5 for the compositional limitations which embrace those recited in claim 2.

The constituents employed, their relative inclusion and the final product of a thread for production of a golf ball are shown by the reference. The reference is silent with respect to the "synthetic isoprene rubber having only a single peak" and the molecular weight distribution of the synthetic isoprene rubber. However, no difference is seen in the compositions or the end-use. A practitioner in the art would know how to

manipulate the constituents to be effective for such end-use, including elasticity and other physical characteristics required. As such, and in view of a lack of unexpected results pertaining thereto, the composition and use of the instant claims would be at least obvious to one of ordinary skill in the art, if not anticipated thereover.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamada et al ('465), newly cited.

The reference to Hamada et al ('465) teaches the manufacture of a golf ball that comprises a "thread wound core," wherein the threads are produced from a blend of "a natural rubber and a synthetic isoprene rubber having a cis-1,4 bond content of at least 90%," as herein recited and claimed. Note column 1 (lines 12-18) for the golf ball construction. Note column 2 (lines 22-65) for the inclusions of the rubber constituents. Further, note column 4 (lines 46-52) for the vulcanization with sheet formation and thread production, and column 4 (line 53) to column 5 (line 3) for the subsequent production of the golf ball using the rubber threads. Note Tables 1 and 2 at columns 5 and 6 for the compositional limitations which embrace those recited in claim 2.

The constituents employed, their relative inclusion and the final product of a thread for production of a golf ball are shown by the reference. The reference is silent with respect to the "synthetic isoprene rubber having only a single peak" and the molecular weight distribution of the synthetic isoprene rubber. However, no difference is seen in the compositions or the end-use. A practitioner in the art would know how to manipulate the constituents to be effective for such end-use, including elasticity and

other physical characteristics required. As such, and in view of a lack of unexpected results pertaining thereto, the composition and use of the instant claims would be at least obvious to one of ordinary skill in the art, if not anticipated thereover.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Akita et al, newly cited.

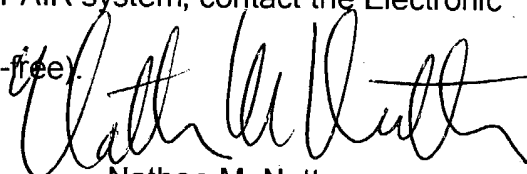
The reference to Akita et al teaches the manufacture of an elastomer/rubber blend that is produced from "natural rubber and a synthetic polyisoprene rubber that may be mixed in any proportion," as herein claimed. The polyisoprene is described as "having a cis-1,4 bond content of at least 90% by mole or more," as herein recited and claimed. Note column 3 (lines 21-36) for these teachings.

The constituents employed and their relative inclusion are shown by the reference. The reference is silent with respect to the "synthetic isoprene rubber having only a single peak" and the molecular weight distribution of the synthetic isoprene rubber. However, no difference is seen in the compositions, as claimed. A practitioner in the art would know how to manipulate the constituents to be effective for such end-use, including elasticity and other physical characteristics required. As such, and in view of a lack of unexpected results pertaining thereto, the composition and use of the instant claims would be at least obvious to one of ordinary skill in the art, if not anticipated thereover.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

7 December 2004